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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,960	09/05/2003	William J. Beyda	2003P11248US	8890
7590 Siemens Corporation Intellectual Property Department 170 Wood Avenue South Iselin, NJ 08830			EXAMINER GAUTHIER, GERALD	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 04/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/655,960

**Applicant(s)**

BEYDA ET AL.

**Examiner**

Gerald Gauthier

**Art Unit**

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 6-13, 16, 17, 21, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 6-13, 16, 17, 21, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1, 4, 6-13, 16, 17, 21, 24 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuhashi et al. (US 7,352,856 B2) in view of Hirano et al. (US 7,257,126 B2).

Regarding **claim 1**, Matsuhashi discloses a dual mode packet phone [Intelligent phone on FIG. 1], comprising:

a first connector to connect the phone with a data network, wherein the data network is a digital Voice-over-IP Ethernet network [The intelligent telephone is connected to an IP network 3 through an IP network interface 107, column 5, lines 23-37]; and

a second connector to connect the phone with a backup network, wherein the backup network is an analog network or a digital time division multiplexing network [The intelligent telephone is connected to a PSTN 2 through a PSTN interface 108, column 5, lines 23-37];

a communications channel to send a communication signal [The intelligent telephone has a PSTN 2 and an IP network 3 as communication channels, column 5, lines 23-37];

a backup switch to connect the communications channel to the first connector or the second connector [The path selector 104 selectively connects the voice I/O unit 102 to a tone/guidance generator 105, a voice-IP packet converter 106, or a PSTN interface 108, column 5, lines 58-65]; and

a control unit to monitor a first connection attempt initiated on the data network and, if a response to the first connection attempt is not received, to control the backup

switch to disconnect the communications channel from the first connector and to connect the communication channel to the second connector [If the destination address information cannot be obtained from the IP call agent 5 or if the IP network telephone number cannot be obtained from the telephone number translation server 4, the call connection basic control unit 10 instructs the tone/guidance generator 105 to send out guidance indicating that PSTN connection mode is selected, column 11, lines 3-16].

Matsuhashi fails to disclose if a response to the first connection attempt is not received within a predetermined time.

However, Hirano teaches if a response to the first connection attempt is not received within a predetermined time [when communication has not taken place in the DCF mode period for a predetermined period of time, the form of the wireless communication system of the present invention is switched, column 16, lines 44-51].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Matsuhashi using the teaching of switching to normal form as taught by Hirano.

This modification of the invention enables the system to switch if a response to the first connection attempt is not received within a predetermined time so that the user would not lose the call.

Regarding **claim 4**, Matsuhashi discloses a phone further comprising a data network interface [Intelligent telephones 1 (1A and 1B) each are connected to a PSTN 2

through a PSTN interface 108 and connected to an IP network 3 through an IP network interface 107, column 5, lines 47-57].

Regarding **claim 6**, Matsuhashi discloses a phone wherein the first connector is an R J-45 Ethernet connector [Intelligent telephones 1 (1A and 1B) each are connected to a PSTN 2 through a PSTN interface 108 and connected to an IP network 3 through an IP network interface 107, column 5, lines 47-57].

Regarding **claim 7**, Matsuhashi discloses a phone wherein the second connector is an R J- 11 connector [Intelligent telephones 1 (1A and 1B) each are connected to a PSTN 2 through a PSTN interface 108 and connected to an IP network 3 through an IP network interface 107, column 5, lines 47-57].

Regarding **claim 8**, Matsuhashi discloses a phone wherein the second connector is in communication with a bypass unit [Intelligent telephones 1 (1A and 1B) each are connected to a PSTN 2 through a PSTN interface 108 and connected to an IP network 3 through an IP network interface 107, column 5, lines 47-57].

Regarding **claim 9**, Matsuhashi discloses a phone, further comprising a bypass unit and wherein: the first connector is an RJ-45 Ethernet connector to a local area network [Intelligent telephones 1 (1A and 1B) each are connected to a PSTN 2 through

a PSTN interface 108 and connected to an IP network 3 through an IP network interface 107, column 5, lines 47-57];

the second connector is an R J-11 connector to a bypass internal analog line; wherein a bypass unit activates the bypass internal analog line through the R J-11 connector when the bypass unit senses an off-hook condition on said line [Intelligent telephones 1 (1A and 1B) each are connected to a PSTN 2 through a PSTN interface 108 and connected to an IP network 3 through an IP network interface 107, column 5, lines 47-57].

Regarding **claim 10**, Matsuhashi discloses a phone, further comprising an analog trunk between the bypass unit and a Public Network [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-57].

Regarding **claim 11**, Matsuhashi discloses a phone further comprising a gateway analog line, and wherein in a normal of operation of the phone, the bypass unit connects the gateway analog line to the analog trunk [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-57].

Regarding **claim 12**, Matsuhashi discloses a phone, wherein the phone shares a set of analog trunks irrespective of whether the gateway analog line or the bypass

internal analog line is passing voice information to the bypass unit [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-57].

Regarding **claim 13**, Matsuhashi discloses a phone, further comprising bypass and gateway. external analog lines that are dedicated trunk circuits from the PSTN [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58].

Regarding **claim 16**, Matsuhashi discloses a phone wherein the TDM network is a standard digital interface [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 58-65].

Regarding **claim 17**, Matsuhashi discloses a phone wherein the TDM network uses at least one of ISDN, Optiset, RolmLink, Nortel, or Avaya protocols [The message 300T to be transmitted from the intelligent telephone 1 to the telephone number translation server 4 is composed of an Ether frame header 301 (Ethernet is a trademark of Xerox Corp.), column 7, lines 64-67].

Regarding **claim 21**, Matsuhashi discloses a phone further comprising:  
a voice processing unit for transmitting and receiving voice signals [The PSTN 2



accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58];

a data network interface in communication with the first connector [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58];

a line interface in communication with the second connector [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58], wherein the backup switch selectively provides a connection between the voice processing unit and either the line interface or the data network interface [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58], and

wherein the control unit comprises a bi-directional link with the voice processing unit, the data network interface, the line interface, and the backup switch [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58].

Regarding **claim 24**, Matsuhashi discloses a phone wherein the backup network comprises an external analog line to a PSTN [The PSTN 2 accommodates an ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58].

Regarding **claim 25**, Matsuhashi discloses a phone wherein the backup network comprises an internal analog line to a bypass unit [The PSTN 2 accommodates an

ordinary telephone (PSTN telephone) 7 besides the intelligent telephones 1, column 5, lines 47-58].

### ***Response to Arguments***

5. Applicant's arguments with respect to **claims 1, 4, 6-13, 16, 17, 21, 24 and 25** have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gerald Gauthier/  
Primary Examiner, Art Unit 2614

GG